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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/304,035 05/03/99 VANZINI

G MSI-254US

022801 MM91/0913
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EXAMINER

KIM.A

ART UNIT

PAPER NUMBER

2876

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/304,035

Applicant(s)

VANZINI ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 22-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I (claims 1- 6 and 22 – 26) in the application
5 09/304,035 is acknowledged. The traversal is on the ground(s) that the Office is likely to search
both subclasses 380 and 382 of class 235 in searching for group I and II (and further II and V,
and thus I, II and V). This is not found persuasive because Group I can function on its own
without the particulars of the Group II. Although the Examiner may agree that the Office will
search for common elements in both groups, the examiner respectfully disagrees that the
10 redundant search for an art is not a valid reason for combining group I and II, or any other groups
thereof as suggested.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

- 15 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 20 (b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

2. Claims 1 – 5, 22 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Dedrick
(US 5,701,884).

Dedrick teaches a computer network system 10 including PCMCIA based smart card 11 with flash memory (col. 2, lines 5 – 10). Data on the smart card is to be accessed with a passcode or PIN (col. 6, lines 59 – 66), and data collected from the smart card and user interaction is used to configure system elements to accommodate users (col. 6, lines 36 – 45; col. 7, lines 39 – 48). Once smart card is removed from the interface, user related data is deleted from the RAM (col. 6, lines 22 – 33; col. 7, lines 5 – 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

10 obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 6, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (US 5,701,884) in view of Barlow et al (US 6,038,551). The teachings of Dedrick have been discussed above.

Although Dedrick teaches encryption in generic terms, Dedrick fails to specifically teach
5 or fairly suggest of encryption where private key resides on smart card and public key is on the host.

Barlow teaches encryption scheme where smart card 14 holds private key and the host 12 has public key (col. 2, line 67 – col. 3, line 3; col. 4, line 60 – col. 5, line 11).

In view of Barlow's teaching, it would have been obvious to an ordinary skill in the art at
10 the time the invention was made to employ notoriously well-known encryption scheme where private key resides on a smart card and public key is available on the host (i.e., PC or the network) to the teachings of Dedrick in order to provide secure communication between the host and a smart card, and protect important/sensitive data from being stolen, and thus an obvious expedient.

15

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Nakano et al. (US 4,727,244); Bialick et al. (US 6,003,135); Kawan et al. (US 5,844,218) disclose smart card, encryption and related methods.

20 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Art Unit: 2876

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
August 31, 2001



KARL D. FRECH
PRIMARY EXAMINER